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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/676,984	09/30/2003	Andrew R. Ferlitsch	10237.32	7696
65400	7590	08/29/2007		
KIRTON & MCCONKIE 1800 EAGLE GATE TOWER / 60 EAST SOUTH TEMPLE P.O. BOX 45120 SALT LAKE CITY, UT 84145-0120			EXAMINER HUNTSINGER, PETER K	
			ART UNIT 2625	PAPER NUMBER
			MAIL DATE 08/29/2007	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/676,984	Applicant(s) FERLITSCH, ANDREW R.	
	Examiner Peter K. Huntsinger	Art Unit 2625	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-25 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-25 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|--|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date <u>1/04</u> . | 6) <input type="checkbox"/> Other: ____ |

DETAILED ACTION

Claim Rejections - 35 USC § 112

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claim 2 and 20 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claim 2 provides the antecedent "the format". The independent claim 1 uses the term "format" in lines 3 and 6 and is therefore unknown which format the applicant intends for the antecedent. A similar correction is required in claim 20.

Claim Rejections - 35 USC § 101

3. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

4. Claims 19-25 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. Claim 19 is directed to a computer program product. For claims 19-25 to be statutory, the applicant must state "A computer readable medium storing a computer program" (or equivalent), not a program comprising a computer readable medium.

Claim Rejections - 35 USC § 102

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5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

6. Claims 1-8 and 12-15, and 18-24 are rejected under 35 U.S.C. 102(a) as being anticipated by Warmus '149.

Referring to claim 1, Warmus '149 discloses in an image rendering environment, a method for dynamically adding one or more document indicia to a document when rendering the document, the method comprising: providing a rendering job in a format that supports at least one of (i) multiple pages, and (ii) multiple images (col. 7, lines 1-6, page description language);

storing one or more document indicia (col. 9, lines 57-61, personalized information, variable image, or the like) as separate sub-images in a native format (col. 7, lines 1-6, variable page files);

correlating one or more pages of the document with one or more of the sub-images (col. 7, lines 24-36, master and variable page files merged);

defining an ordered subset of the sub-images to apply to the document (col. 7, lines 6-10, press command file specifies the manner in which the master and variable files are to be merged); and

using a process to associate the one or more sub-images with one or more of the pages of the document when rendering the document, wherein the process is one of (i)

an overlay process, (ii) an underlay process, and (iii) a composite process (col. 20, lines 1-10, overlay the variable pages on the master pages).

Referring to claim 2, Warmus '149 discloses wherein the format is one of:

- (i) a tagged image file format; and
- (ii) a portable document format (col. 4, lines 21-31, TIFF file).

Referring to claim 3, Warmus '149 discloses wherein the document indicia is disbound from page data of the rendering job (col. 20, lines 1-10, overlay the variable pages on the master pages).

Referring to claim 4, Warmus '149 discloses wherein the step for correlating one or more pages of the document with one or more of the sub-images comprises a step for linking the one or more pages in a next list (col. 7, lines 6-10, press command file specifies the manner in which the master and variable files are to be merged).

Referring to claim 5, Warmus '149 discloses wherein the step for correlating one or more pages of the document with one or more of the sub-images comprises a step for sub-chaining the one or more sub-images from page images by a sub list (col. 7, lines 6-10, press command file specifies the manner in which the master and variable files are to be merged).

Referring to claim 6, Warmus '149 discloses wherein the step for correlating one or more pages of the document with one or more of the sub-images comprises sub-chaining the one or more sub-images within sub-images (col. 11-12, lines 62-67, 1-22, object inserted defined by curser, user can insert multiple objects).

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Referring to claim 7, Warmus '149 discloses wherein the step for defining an ordered subset of the sub-images comprises creating a set of instructions in one of

- (i) a dynamic manner, and
- (ii) a static manner (col. 20, lines 49-54).

Referring to claim 8, Warmus '149 discloses wherein the overlay process includes applying an overlay on top of one of:

- (i) a page image; and
- (ii) another sub-image (col. 20, lines 1-10, overlay the variable pages on the master pages).

Referring to claim 12, Warmus '149 discloses wherein the composite process includes merging a composite with at least one of:

- (i) a page image; and
- (ii) another sub-image (col. 23, lines 28-32, the master and variable pages are merged).

Referring to claim 13, Warmus '149 discloses In a printing environment, a method for adding document indicia when printing an image without the use of a printer driver, the method comprising:

using a multi-subfile extension (Fig. 5, col. 11, lines 18-29, file 130 includes file portions) to represent multiple sub-images of a TIFF image, wherein data of the TIFF image is not converted into printing instructions by an application (col. 23, lines 21-23, files 122, 137, and 138 preprocessed to TIFF format);

using an extension to group and locate the sub-images on a page (Fig. 5, col. 11, lines 18-29, file 130 includes file portions);

providing one or more electronic tags to perform at least one of:

supporting an overlay of the multiple sub-images on the page (col. 20, lines 1-10, overlay the variable pages on the master pages).;

supporting an underlay of the multiple sub-images on the page;

supporting a composite of the multiple sub-images on the page;

specifying a merge order of the multiple sub-images on the page;

specifying a location for merging the multiple sub-images on the page; and

specifying any scaling of the multiple sub-images; and

selectively rendering the TIFF image based on the electronic tags (col. 23, lines 21-35, process the pages for printing).

Referring to claim 14, see the rejection of claim 8 above.

Referring to claim 15, see the rejection of claim 9 above.

Referring to claim 18, see the rejection of claim 12 above.

Referring to claim 19, see the rejection of claim 1 above.

Referring to claim 20, see the rejection of claim 2 above.

Referring to claim 21, see the rejection of claim 4 above.

Referring to claim 22, see the rejection of claim 7 above.

Referring to claim 23, see the rejection of claim 8 above.

Referring to claim 24, see the rejection of claim 9 above.

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 9-11, 16, 17 and 25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Warmus '149 as applied to claims 1, 8, 13, and 23 above, and further in view of well known prior art.

Referring to claim 9, Warmus '149 discloses the overlay but does not disclose expressly overlaying a form, page numbering, header, footer, or caption. Official Notice is taken that it is well known and obvious in the art to overlay one of:

- (i) a form;
- (ii) a page numbering;
- (iii) a header;
- (iv) a footer; and
- (v) a caption (See MPEP 2144.03).

The motivation for doing so would have been to provide useful information on all printed pages of a document. Therefore, it would have been obvious to combine well known prior art with Warmus '149 to obtain the invention as specified in claim 9.

Referring to claim 10, Warmus '149 discloses wherein the overlay process includes applying an overlay on top of one of:

- (i) a page image; and

(ii) another sub-image (col. 20, lines 1-10, overlay the variable pages on the master pages).

Warmus '149 does not disclose expressly applying an underlay process. Official Notice is taken that it is well known and obvious in the art to apply an underlay (See MPEP 2144.03). The motivation for doing so would have been to retain the information of the master page of the overlapping region as opposed to the variable page. Therefore it would have been obvious to combine well known prior art with Warmus '149 to obtain the invention as specified in claim 10.

Referring to claim 11, Warmus '149 discloses adding document indicia to a document but does not disclose expressly a watermark. Official Notice is taken that it is well known and obvious in the art to utilize a watermark when printing a document (See MPEP 2144.03). The motivation for doing so would have been to protect a document from counterfeit. Therefore it would have been obvious to combine well known prior art with Warmus '149 to obtain the invention as specified in claim 11.

Referring to claim 16, see the rejection of claim 10 above.

Referring to claim 17, see the rejection of claim 11 above.

Referring to claim 25, see the rejection of claim 11 above.

Conclusion

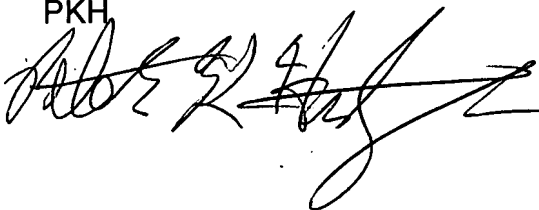
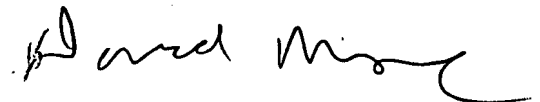
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Peter K. Huntsinger whose telephone number is (571)272-7435. The examiner can normally be reached on Monday - Friday.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Moe Aung can be reached on (571)272-7314. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

PKH

A handwritten signature in black ink, appearing to be 'PKH' followed by a stylized flourish.A handwritten signature in black ink, appearing to be 'David Moore'.

DAVID MOORE
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2600